

REMARKS

Claims 1-36 are pending in the application.

Claims 1-36 have been rejected.

Rejection of Claims Under 35 U.S.C. §103

Claims 1-36 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent No. 6,587,126 issued to Wakai et al. (“Wakai”) in view of U.S. Patent No. 6,421,733 issued to Tso et al. (“Tso”). Applications respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 1, 9, 16, 23 and 30 each contain limitations of substantially the following form:

receiving a request to provide a requested service, wherein the request is received from an applet executing on a remote network node.

See, e.g., Claim 1. Applicants respectfully submit that the cited sections of Wakai fail to provide disclosure of the claimed applet that provides the request to provide a requested service.

The Office Action cites to Wakai's web browsers 202 and 203 as purportedly providing disclosure of the claimed applet. But the cited elements of Figure 2 of Wakai provide no explicit disclosure of applets providing the claimed request to provide a service. Without such explicit disclosure, the Office Action must be relying upon the disclosed web browsers as providing inherent disclosure. But in order for an element to be inherently disclosed, that element must necessarily be present in the cited disclosure. *See* MPEP §211(IV); *see also* *In re Robertson*, 169 F.3d 743,745 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill'"). The Office Action fails to provide any evidence that the claimed applets are necessarily present in Wakai's web browsers.

Applicants respectfully submit that applets that provide a request to provide a service need not be necessarily present in the disclosed browsers. Wakai discloses the browsers to function as conversion mechanisms, but there is no disclosure of how this conversion is accomplished. *See* Wakai 13:47-54 ("an instruction for starting the processing is converted into a request by the Web browser 202, while an instruction for displaying the status of a device (printer 206) is converted into a request by the Web browser 203"); *see also* Wakai 14:42-45. In fact, Wakai discloses that the browsers themselves purportedly provide the "converting" and does not disclose software running on or in conjunction with the browsers (such as an applet) as providing that functionality. While an applet provided by a server may be interpreted by a browser, there is no disclosure that the operations cited in Wakai actually do or necessarily must do so. Finally, while the cited sections of Wakai fail to provide disclosure of the claimed applets, the Office Action offers no citation to any section of Tso that purportedly will

provide such disclosure. Therefore, Applicants respectfully submit that neither the cited sections of Wakai, nor Tso, alone or in combination, provide disclosure of the claimed applet that can provide a request to provide a service.

Independent Claims 1, 9, 16, 23 and 30 each further contain limitations of substantially the following form:

selecting a first device of a plurality of devices to provide the requested service, wherein ... said selecting is performed in response to said obtaining the results of parsing.

See, e.g., Claim 1. Applicants respectfully submit that neither the cited sections of Wakai nor Tso, alone or in combination, provide disclosure of these claim limitations.

The Office Action admits that Wakai fails to provide disclosure of the claimed language parser or functionality related to that parser. *See, e.g.*, Office Action, pp.5-6. Instead, the Office Action relies upon cited sections of Tso for such functionality. Since, by the Office Action's own admission, Wakai does not provide for the language parser, then Wakai cannot provide for the claimed selecting "in response to said obtaining the results of parsing."

Even so, the Office Action offers a logical inconsistency by stating that "the module of selecting instructions (i.e. selecting before identifying) are inherently performed in response to the module of obtaining request instruction as there is more than one option that the request may be directed including the option to request for scanning by the scanner ... and the option to request for printing by the printer." As stated above, inherent disclosure requires that the suggested disclosure must necessarily be present. But the Office Action has admitted that Wakai fails to provide such functionality and therefore cannot be necessarily present, as required.

Further, if Wakai did provide such functionality, that would be an admission by

the Office Action that any suggestion to combine Wakai with another reference (such as Tso) to provide such functionality would be cumulative. Therefore there would be no motivation to combine Wakai with another reference to provide that functionality. By introducing this logical inconsistency in construing the references, the Office Action appears to be trying to have it both ways, which is impermissible.

In addition, in several locations, the Office Action posits that it is Wakai's "desktop PC" (Fig. 7, ref. 706) that performs functionality equivalent to the claimed "selecting." *See, e.g.*, Office Action, pp.4-5. Since Wakai fails to explicitly provide for such selecting, the Office Action also states that selecting "must be inherently performed [by the desktop PC] in response to obtaining the request." *See, e.g.*, Office Action, p.4-5 (again, the Office Action includes an inherency argument without any support for the necessity of such selecting being present.)

In light of these statements by the Office Action as to where the "selecting" is performed in Wakai, Applicants submit that the cited sections of Wakai fail to provide disclosure of the amended claim limitations. The independent claims provide for receiving the request for the requested service from an applet executing on a remote network node. The cited sections of Wakai provide no disclosure of the "desktop PC" receiving such a request, nor do those sections provide for a request to be provided by an applet executing on a remote network node.

The claims provide that the claimed selecting is performed "in response to said obtaining the results of parsing [the request]" by a language parser. The cited sections do not disclose the "desktop PC" to perform any selecting process in response to obtaining results of language parsing of the request. The cited sections of Wakai fail to show a language parser of any kind available to the desktop PC, which would be used to parse a

request for a requested service.

In order to address this deficiency in the disclosure of Wakai, the Office Action uses Tso. *See* Office Action, p.6. Tso provides a parser (22) that purportedly “is responsible for selectively invoking one or more of transcode service providers” (Tso 3:15-16), wherein the parser is part of a transcoding server used to link a network client to the internet. *See* Tso, Fig.3 & Tso 3:8-65. Tso provides such a transcoder to manipulate data being transmitted between a network client and an internet network through the use of the transcode service providers, which perform tasks such as compressing and scaling data. *See* Tso 3:45-65.

Placing Tso’s transcoder parser in Wakai’s desktop PC, as suggested by the Office Action, would not provide the functionality claimed. As stated above, Wakai’s desktop PC does not receive requests generated by an applet. Further, if, as suggested by the Office Action, Wakai’s desktop PC already performs the claimed “selecting” then it would be cumulative to also provide Tso’s parser to perform selecting as well. Finally, there is no suggestion within Tso that Tso’s parser would function in the environment provided by Wakai or what such a parser’s function would be in such an environment.

Applicants further submit that even were Wakai and Tso construed as teaching or suggesting all of the limitations for which they are cited (a notion with which Applicants respectfully disagree), the Examiner has not satisfied the burden of factually supporting the alleged motivation to combine the references. The proper rationale for arriving at a conclusion of obviousness, as suggested by the U.S. Supreme Court in *KSR International Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007), include the following tests for determining a motivation to combine elements from the prior art:

- A. Combining prior art elements according to known methods to yield predictable results;
- B. Simple substitution of one known element for another to obtain predictable results;
- C. Use of a known technique to improve similar devices in the same way;
- D. Applying a known technique to a known device ready for improvement to yield predictable results;
- E. “Obvious to try” – choosing from a finite number identified, predictable solutions, with a reasonable expectation of success; and
- F. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Examiner must provide evidence applied to these tests to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as also required by 35 U.S.C. § 103(a). Instead of establishing any of the above criteria, the Office Action merely offers conclusory statements of combinability.

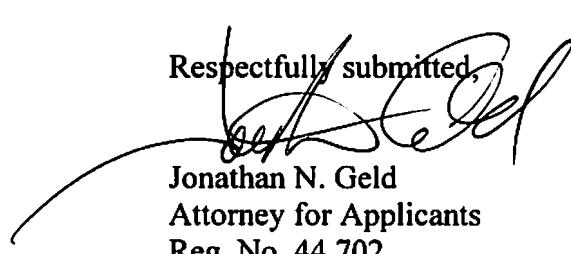
The Office Action suggests that motivation to combine the references can be found “for the benefit of enabling the manipulation of transferred data between the client computer and the network computer without changing existing hardware to obtain the invention as specified in Claims 1, 9, 16, 23 and 30. As an initial matter, such motivation appears to be founded in combining the references in order to obtain the claimed invention, which is tantamount to using the claimed invention as a blueprint to combining the references. This is contrary to well-established case law. Further, any indication that Wakai need be modified at all to provide “selecting” is contrary to the Office Action’s own statements that selecting is already provided by Wakai.

For at least these reasons, Applicants submit that neither Wakai nor Tso, alone or in combination, provide disclosure of all the limitations of independent Claims 1, 9, 16, 23 and 30, and all claims depending therefrom, and that these claims are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

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